## REMARKS

Applicants respectfully request reconsideration of this application in view of the following remarks. Claim 35 has been amended. Claims 1-27 and 41-52 have been withdrawn by the Office Action. Thus, claims 28-40 are currently pending in the application and subject to examination. Applicants respectfully submit that no new matter has been added.

## Withdrawn Claims

The Examiner has withdrawn claims 1-28 and 41-52 in response to Applicants' election with traverse. Applicants reserve the right to petition the restriction under 37 C.F.R. § 1.144. Applicants further reserve the right to file divisional applications on all nonelected claims.

## Objections to the Claims

The Office Action objects to Claim 35 for containing informalities. Claim 35 has been amended responsive to this rejection. If any additional amendment is necessary to overcome this rejection, the Examiner is requested to contact the Applicant's undersigned representative.

## Claim Rejections

Claims 28, 29, 31, 36, 38, and 40 are rejected under 35 U.S.C. § 102(e) as being anticipated by Bernstein et al. (U.S. Patent No. 5,204,947, hereinafter "Bernstein"). Additionally, claim 30 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bernstein in view of Ohara et al. (U.S. Patent No. 5,739,814, hereinafter "Ohara"). Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bernstein in view of Woodill (WO 91/11769). Claims 33-35 and 37 are rejected under 35 U.S.C.

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§ 103(a) as being unpatentable over Bernstein in view of Kannes (U.S. Patent No. 4,965,819). Claim 39 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bernstein in view of Quentin et al. (U.S. Patent No. 5,208,745, hereinafter "Quentin"). Applicants respectfully traverse these rejections.

Claim 28 discloses at least an electronic book comprising a link to an Internet web site, the web site providing a plurality of streaming video, audio, and text data when connected to the electronic book, a control function, which allows selection of one or more of streaming video, audio, and text data, and where the selected data are displayed with display of the electronic book.

Bernstein discloses an invention that "may be run on a variety of computers under a number of different Operating Systems (OS). The computer could be, for example, a personal computer, a mini computer, or a mainframe computer. The computer may [be] a standalone system, part of a network such as a Local Area Network or Wide Area Network or a larger teleprocessing system." (Bernstein, col. 6, lines 60-69). The Office Action takes the position that "a personal computer, a mini computer or a mainframe computer" is the equivalent of an electronic book. However, this is an overbroad definition of a computer that could encompass nearly any electronic device. An electronic book does some of the functions that a computer does, and has some structural similarity, but none of what is listed in Bernstein teaches an electronic book as presented in the claimed invention.

The Office Action further takes the position that Bernstein discloses "a link to an Internet web site, the web site providing a plurality of streaming video, audio, and text data when connected to the electronic book." As support for this position, the Office

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Action cites Figure 5 of Bernstein (see Office Action, page 3, section 4). Figure 5 of Bernstein discloses a flowchart whereby a client application calls the link manager services, which interacts with a "web database" and a "web viewer". Despite its nomenclatural similarities to the "World Wide Web," a common moniker for the Internet, the "web database" and "web viewer" of Figure 5 do not represent the Internet, nor any similar system. The "web database" of Figure 5 is merely a database of definitions of links. The "web" of Figure 5 is defined as, "a collection of document, link, and link marker definitions. The web represents all the information required by LMS to navigate the defined associations." (Bernstein, col. 9, lines 21-25). The "web" is further defined as a separate database, not containing information, but rather containing "all information needed to support links between documents." (see Bernstein, col. 22, lines 52-54). The "web" disclosed by Bernstein is therefore not analogous to the Internet or a web site; in fact, the "web" of Bernstein discloses the opposite idea. On the Internet, each individual web page has embedded within itself links to other web pages, and does not depend on nor need a central database of links separate from the document in order to function. Such a database as the "web" of Figure 5 would defeat the functionality of the Internet.

Further, the claimed invention makes use of "the web site providing a plurality of streaming video, audio, and text data when connected to the electronic book." No audio, video, or text data transfer is disclosed by Bernstein, only a series of links to that data. Additionally, even if Bernstein did disclose the transfer of data, it provides no functionality for "streaming" that data as proposed in the claimed invention.

To qualify as prior art under 35 U.S.C. § 102(e), a single reference must teach or disclose each feature of a rejected claim. For the reasons provided above, Applicants

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submit that claim 28 is allowable over the cited prior art. As claim 28 is allowable, Applicants submit that claims 29, 31, 36, 38, and 40, which depend from independent claim 28, are also allowable over the cited prior art for at least the same reasons as listed above.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03. As discussed above, Bernstein does not teach or suggest all the features set forth by independent claim 28. As such, Applicants submit that claim 30, which depends from independent claim 28, and is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bernstein in view of Ohara, is allowable for at least the same reasons that claim 28 is allowable.

Applicants further submit that claim 32, which also depends from independent claim 28, and is rejected under 35 U.S.C § 103(a) as being unpatentable over Bernstein in view of Woodill, is allowable for at least the same reasons that claim 28 is allowable.

Similarly, Applicants submit that claims 33-35 and 37, which depend either directly or indirectly from claim 28, and are rejected under 35 U.S.C § 103(a) as being unpatentable over Bernstein in view of Kannes, are allowable for at least the same reasons that claim 28 is allowable.

Finally, Applicants submit that claim 39, which depends from independent claim 28, and is rejected under 35 U.S.C. § 103(a) as being unpatentable over Bernstein in view of Quentin, is allowable for at least the same reasons that claim 28 is allowable.
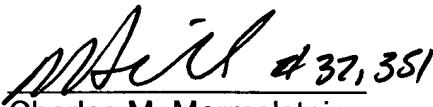
## Conclusion

For all of the above reasons, Applicants respectfully submit that the claims now pending patentably distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, referencing Attorney Docket Number 026880-00035.

Respectfully submitted,

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Enclosure:    Petition for Extension of Time (2 months)

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